

REMARKS:

Claims 6, 8 and 10-13 are in the case and presented for consideration.

Independent claims 6 and 11 have been amended to limit the invention to a probe set and method specifically for use in nasolacrimal duct surgery. Both the probe set and the method are limited to requiring a direct mechanical attachment and electrical connection between the wires of the circuit and the respective conductive parts of the probe and the tool. In this way, only when the probe and the tool directly and physically touch each other, is the signal generated. No new matter has been added.

Where an audio signal is used (the claims indicate that the signal can be either visual or audio) the practitioner (i.e. an ophthalmologist) knows that he or she has found the probe and can then quickly hook onto the probe to complete the process of pulling the probe through the lacrimal duct.

It is important that the surgeon first locate and then hook onto the probe as soon as possible since this reduces the time the patient is under anaesthesia and also minimizes trauma which results if the doctor must move the tool around extensively in the nasal cavity (the inferior nasal meatus) to locate the probe.

Before discussing the combination of references cited by the Examiner in holding that the previous claims were obvious under 35 U.S.C. 103, the subject co-inventor Peter Michalos, M.D., a long practicing and well respected ophthalmologist (not the undersigned patent attorney who's name also happens to be Peter Michalos) is prepared to provide a rule 132 declaration if necessary, concerning the non-obviousness of the combination of prior art cited, to those having ordinary skill in this art, to reach the invention and on the

new, advantageous and unexpected results achieved by the invention as claimed. Dr. Michalos has also told the undersigned that other specialist in this field are prepared to provide similar declarations if necessary.

Turning now to the Office Action, claims 6 and 11 have been rejected as being obvious from a combination of U.S. Patent 4,380,329 to Crawford et al. which is the acknowledged prior art probe set from which the present invention diverts, in view of U.S. patent 5,078,714 to Katims, which discloses a method and apparatus for placing a blood vessel probe, and that has no teaching of a mechanical touching or direct electrical connection between a probe and a tool.

While in Fig. 2A of the Katims, the use of a clip 31 at the end of one wire 32 for attaching to a tool is shown, the other wire 33 is connected to a skin patch 34 which can only establish an electrical impedance pathway shown at D and P in Fig. 1, as discussed by Katims at column 8, line 47 to column 9, line 4.

The person of ordinary skill in this field such as a practicing ophthalmologist, would not find it obvious to combine the teaching of Crawford which discloses a probe set but no way of determining by generation of an audible or visual signal when the tool touches the probe, with Katims which deals with blood vessels and a completely different part of the body and a very different technique that teach no direct contact between a probe and a tool, and which, in fact, precludes any such contact because the tool is inside a blood vessel 12 (see Fig. 1 of Katims) and would have to puncture the blood vessel to make such contact.

The subject inventor, Dr. Peter Michalos is prepared to provide a declaration which states the following. The undersigned confirms that Dr. Michalos has in fact made this

statements in writing to the undersigned and the undersigned presents these statements as verified facts in his capacity as a registered patent attorney.

In the words of Dr. Michalos:

“It is not obvious to an ophthalmologist who does tear duct surgery to use a different method other than a feeling in the nose to touch metal [the probe] and mechanically pull a tube out of the nose. A low voltage circuit with sound changes the paradigm of the proprioception and special awareness required to pass the tubes. It is about assisting the surgeon to position the hook to pass tubes with minimum trauma and reduced anaesthesia times.”

The claims have been limited to the field where ophthalmologists would work and also have better defined the direct mechanical and electrical connection required between the circuit and the probe and tool as well as the direct contact between the probe and tool, which is necessary to generate the signal.

Claims 6 and 11 are therefore believed to be clearly patentable over the prior art in that they are neither anticipated nor obvious to those having ordinary skill in this field as contemplated by the 35 U.S.C. 103 and also as that statute has most recently been interpreted by the U.S. Supreme Court in *KSR v. Teleflex*.

While the examiner cites the further reference to Hook, U.S. Patent 1,668,847 to show that clips are known for making electrical connections, this would not induce an ophthalmologist to combine Hook with Crawford and Katmis since there would no be purpose to that combination and even adding the teaching of Katims would not teach the skilled artist in this field the importance of a direct mechanical and electrical connection

between the probe and the tool (in other words, they must actually physically touch each other) and only that touching can help the doctor engage and hook the tool onto the probe.

The Katims teaching only provides an indication of the electrical impedance between two metal parts that are necessarily spaced from each other and as the electricity passes through the intervening body tissues. This measurement would have no use whatsoever to the ophthalmologist who is trying to hook onto the probe and is given a valuable tool in the form of an audible or visual signal to indicate that the hook has actually touched the probe by the claimed invention.

No such signal is contemplated or taught by Katims and certainly Crawford or Hook cannot supply the missing teaching.

Claims 8 and 12 are thus believed to be even more remote from the cited references.

Use of battery power makes the units easily transportable and very amenable to the operating theater or office where the eye surgery of the type contemplated by the present invention is contemplated. This is believed to further evidence the patentability of dependent claims 10 and 13 over the prior art cited.

By this amendment thus, the application and claims are believed to be in condition

for allowance.

If any issues remain, the Examiner is respectfully invited to contact the undersigned at the number below, to advance the application to allowance.

Favorable action is respectfully requested.

Respectfully submitted,

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Dated: April 25, 2008

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